

Remarks

Claims 1-3 and 5-29 remain pending. Claims 1 and 11 have been amended herein. No new matter is believed added.

1. 35 U.S.C. 101 Rejection

In the Office Action, claims 1-3, 7-10, 13-15 and 23-29 are rejected under 35 U.S.C. 101 as allegedly being directed to non-statutory subject matter. With regard to claims 13-15 and 23-29, Applicant respectfully traverses this rejection because the invention as claimed includes tangible things, e.g., a solution advisor tool (of claim 13) including a knowledge management system, a design interface system, a specifying system, etc., and a system for designing a solution (of claim 23). That is, the invention as claimed in claims 13-15 and 23-29 is not non-functional descriptive materials.

By this Amendment, claim 1 has been amended to include "a system for combining the information managed in the knowledge bases to generate an information technology design solution including a set of network units[.]" which is clearly a tangible thing.

In addition, the current invention as claimed includes a practical utility, for example, "generating the IT solution[.]" (Claim 13, similarly included in claims 1 and 23). Generating the IT solution can happen outside a computer and is not just the transformation of data within a computer. For example, as claimed in claim 1, the information technology design solution generated includes a set of network units which may be hardware products. In addition, generating IT solutions using the framework of the claimed invention affects, e.g., a product development process and as a consequence

creates efficiency and productivity in the operation of the business process of information technology design, which are obviously “useful, concrete and tangible result[s].” State St. Bank & Trust Co. v. Signature Fin. Group, 149 F.3d 1368, 1373 (Fed. Cir. 1998).

2. 35 U.S.C. 103(a) Rejection

Claims 1-3, and 5-29 are rejected under 35 U.S.C. 103(a) over Douik et al. (US 6,012,152), hereafter “Douik,” in view of Kohn et al. (US 5,963,447), hereafter “Kohn.” This rejection is defective because the combination of Douik and Kohn fails to teach or suggest each and every feature set forth in the claims as required by 35 U.S.C. 103(a).

Independent claim 1 includes, among other features, a “fourth knowledge base that includes clouds, wherein each cloud describes a set of all possible configurations that can fulfill a predetermined function that the cloud represents.” Independent claims 13, 19, and 23 include similar features. In the above-referenced Office Action, the Examiner admits that Douik fails to teach or suggest this feature. In particular, the Examiner states on page 5 of the Office Action that “Douik doesn’t explicitly disclose a fourth knowledge base wherein each cloud describes a set of possible configurations that can fulfill a predetermined function.” In order to overcome this glaring deficiency of Douik, the Examiner relies on the teachings of Kohn. Specifically, the Examiner alleges that “Kohn, discloses in an analogous art a knowledge base system which supports configuration and incremental change of scenerios [*sic.*] (possible combinations) 8:65-9:15.” (Office Action at page 5). To support the combination of Douik and Kohn, the Examiner alleges that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Douik and Kohn because, it would enable architectures ‘to have built-in

flexibility incrementally improve on fixed architectures” (Id., inner citation omitted).

Applicant respectfully disagrees with the Examiner’s analysis and conclusion.

First, Kohn does not teach or suggest a “fourth knowledge base that includes clouds, wherein **each cloud describes a set of all possible configurations that can fulfill a predetermined function that the cloud represents.**” (Claim 1, emphasis added). On the contrary, the MAHCA of Kohn only provides an architecture for the design and implementation of the control of systems distributed in space and/or time. Specifically, in col. 8, line 65 to col. 9, line 15 of Kohn, which are relied by the Examiner to disclose the above feature of the claimed invention, the so-called configuration and incremental change of scenarios of activities are the goals/advantages that Kohn attempts to achieve, but are not disclosed features of Kohn. Applicant submits that the Office needs to cite specific disclosures of Kohn, not the announced goals/advantages, in the rejection of the current invention. In other words, the Office does not even assert how (or whether) Kohn achieves those advantages/goals. In addition, even the above-identified announced advantages/goals of Kohn include only change of activities, not all possible configurations that can fulfill a predetermined function that the cloud represents, as included in the claimed invention. That is, the cited section of Kohn does not disclose or suggest a “fourth knowledge base that includes clouds, wherein each cloud describes a set of all possible configurations that can fulfill a predetermined function that the cloud represents.”

Kohn only, through strictly mimicking the operation of a real system, incrementally expands the functionality of an agent of the system. The action (function) of each agent in Kohn is based on three information items, i.e., sensory data or on-line

status data, information in the agent's knowledge base, and inter-agent constraints or on-line status information from other agents. (See col. 18, lines 9-13.) The so-called knowledge base in Kohn is only the storage mechanism for storing the "active knowledge or selected information data[.]" (Col. 18, lines 10-11). More specifically, "[t]he Knowledge Base 28 stores the requirements of operations or processes controlled by the agent [and] ... also encodes system constraints, integrated protocols and constraints, sensory data, operational and logic principles, and a set of primitive inference operations defined in the domain of equational terms." (Col. 19, lines 6-13). That is, the knowledge base of Kohn does not include a cloud that describes a set of all possible configurations that can fulfill a predetermined function that the cloud represents. In view of the foregoing, the suggested combination does not disclose or suggest each and every claimed feature.

Second, Applicant submits that there is no suggestion or motivation to combine Kohn and Douik. Douik discloses a software fault management system which functions as a troubleshooter and assists in the diagnosis of problems. (See abstract and col. 13, lines 7-22.) That is, Douik does not have any motivation to "have built-in flexibility incrementally improve on fixed architectures[.]" as is allegedly announced to be advantages in Kohn (Office Action at page 5, citing Kohn at col. 9, lines 20-23). The reason is that a troubleshooter like the Douik system is not expected to, and not desired to, attempt to improve the fixed architecture, which will only make the problem diagnosis unnecessarily complicated. As such, adoption of the alleged advantages of Kohn regarding the incremental improvement on fixed architecture will make Douik unsatisfactory for its intended purpose. In view of the foregoing, there is no suggestion

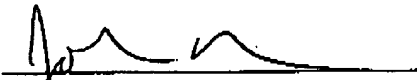
or motivation to combine Douik and Kohn. Applicant submits that the Office can obtain suggestion or motivation to combine Douik and Kohn only from the hindsight teachings of the claimed invention, which is not warranted in a Section 103 rejection.

In view of the foregoing, Applicant submits that the Office fails to establish a *prima facie* case of obviousness and respectfully requests withdrawal of the rejection. The dependent claims are believed allowable for the same reasons stated above, as well as for their own additional features.

If the Examiner believes that anything further is necessary to place the application in condition for allowance, the Examiner is requested to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

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